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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

HO, UYEN T

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

| | | | |
|------------------------------|-------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/686,004 | NGUYEN ET AL. | |
| | Examiner | Art Unit | |
| | (Jackie) Tan-Uyen T. Ho | 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I: Figs 1-5 (readable on claims 1-16) in Paper No. 10 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Pyka et al. (5,002,563).

In regard to claim 1, Pyka et al. disclose a method of holding two tissue parts together including the steps of: providing a clip having two end points which are separated from each other when the clip is in an open configuration and tending to return to a naturally close configuration by reducing distance between the end points when in the open configuration (figs. 7A, 8B, col. 4, lines 26-57 and col. 8, line 36 to col. 9, line 50); placing the clip across the two tissue parts such that the two end points each penetrate completely a different one of the two tissue parts (figs. 7A, 8A); allowing the clip to tend to return to the closed configuration, whereby the two tissue parts are held together by the clip (figs. 7B, 8B).

In regard to claim 6, the clip comprises a wire made of a shape memory material (col. 5, lines 26-57 and col. 8, line 36 to col. 9, line 50).

In regard to claim 7, the clip in the closed configuration is looped by more than 360 degrees (figs. 7B, 8B).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyka et al. '563 in view of Northrup, III et al. (5,972,024) and Ebert (5,127,413). Pyka et al. disclose a method for holding two tissue parts together by using a clip, the clip including two end points. Pyka et al. fail to disclose the two end points are each detachably attached to a needle through a flexible member. Northrup, III et al. disclose a clip (60) having an end point detachably attached to a needle (40) through a flexible member (20) and because the member is flexible than the clip, it provides a great advantage of passing through the anatomic structures. Ebert teaches a spiral clip having first and second ends, a first needle attached to the first end and a second needle attached to a second end of the clip to provide greater safety and accurate placement for the spiral clip. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the two needles and flexible members into Pyka et al.'s clip in order to easily and accurately place the clip across the two tissue parts.

6. Claims 3-5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teaching of Pyka et al. '563 in view of Northrup, III et al. '024 and Ebert '413 further in view of Hasson (5,628,757). The combined teaching Pyka et al. '563 in view of Northrup, III et al. '024 and Ebert '413 discloses a clip having two ends attached to needles through flexible members. Although, the combined teaching fails to disclose a needle holding including an outer tube, an inner tube having a slit for grabbing a needle therein and a spring disposed inside the outer tube to apply a biasing force on the inner member backward away from the front end, attention is directed to the Hasson reference which discloses a needle holding (fig. 3) including an outer tube (82), an inner tube (32) having a slit (20) for grabbing a needle therein and a spring (110) disposed inside the outer tube to apply a biasing force (when the member 106 is drawn backward) on the inner member backward away from the front end (fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a needle holder as taught by Hasson into the combined teaching of Pyka et al. in view of Northrup, III et al. and Ebert in order to place the clip across the tissue parts and wherein so doing the method steps as claimed in claims 3-5 are inherently performed.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boebel et al. (5,454,834) disclose a suture having spiral loops.

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Fleischman et al. (5,984,917) disclose a shape memory clip.

Camps et al. (5,871,528) disclose needles attached to a spiral element through flexible members.

Hermens (5,217,027) discloses needles attached to a spiral element through flexible members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


(Jackie) Tan-Uyen T. Ho
September 9, 2002


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700